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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,701	11/14/2001	Herbert Gruber	H55-061 US	7489
21706	7590	03/23/2004	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			KUHN, ALLAN R	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,701

Applicant(s)

GRUBER ET AL.

Examiner

Allan Kuhns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1.Claim 4 is still rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As set forth in the previous Office action, one of ordinary skill in the art would be unable to establish the metes and bounds of claim 4 in order not to infringe since there is no baseline provided to establish "the usual maximum speed in the injection operation". Clarification is required.

2.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierick et al. (WO 98/31521). Pierick et al. disclose or suggest the basic claimed injection molding process for the injection into a mold of a single phase solution (page 3, lines 5-10) of a polymer and a propellant in a plasticizing cylinder of an injection molding machine, characterized in that the connection between the plasticizing cylinder and the mold is interrupted (note the description of the action of mechanical shut-off valve 64 beginning at page 19, line 1). It would have been obvious to one of ordinary skill in the art that the maximum speed of displacement (for example, in the axial direction) of screw 38 is limited because (1) there are physical limitations involving how fast such a screw could be moved, and (2) when the screw reaches a fully retracted position, as

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described at page 19, line 17, its maximum speed of movement in the direction of retraction is limited since it is already fully retracted.

Pierick et al. teach or suggest a pressure within the range of claim 3 at page 11, line 17, and it is submitted that the maximum speed of retraction of the screw 38 in Pierick et al. is zero, as in claim 5, because the screw of Pierick et al. is not retracted until shut-off valve 64 is closed (as described on page 19).

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierick et al. as applied to claims 1, 3 and 5 above, and further in view of Nishikawa et al. The relevant teachings of Nishikawa et al. and reason for combination with the primary reference (in this case Pierick et al.) are as set forth in the previous Office action.

5. Applicant's arguments filed December 11, 2003 have been fully considered but they are not persuasive. Some of applicant's arguments are considered to be moot based on the revised grounds of rejection introduced in this Office action. Applicant does argue that the prior art relied upon by the examiner only deals with an injection process under "normal" conditions while the claimed invention deals with sudden stops in the injection process which then raise the issue of what to do with the single phase solution when the normal injection process is stopped. This argument is not persuasive since it is not commensurate in scope with the process as instantly claimed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (571) 272-1202. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaiani, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Allan R. Kuhns
ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732
3-19-04